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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/719,745	EDWARDS ET AL.
Office Action Summary	Examiner	Art Unit
	Myles D. Robinson	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>15 July 2009</u>.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1 - 16, 23 - 28 and 30 - 48</u> is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1 - 16, 23 - 28 and 30 - 48</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>21 November 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a) ☐ All b) ☐ Some * c) ☐ None of:
         1. ☐ Certified copies of the priority documents have been received.
         2. ☐ Certified copies of the priority documents have been received in Application No. _____.
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1.   DETAILED ACTION

Response to Amendment

1.   Applicant's amendment was received on 7/15/2009, and has been entered and

made of record. Currently, **claims 1 – 16, 23 – 28 and 30 – 48** are pending.

Response to Arguments

2.   Applicant's arguments (*see Remarks 7/15/2009*) with respect to the rejection(s)

of **claims 1, 2, 4, 5, 9, 23, 24 and 26** under 35 U.S.C. §102(e) have been fully

considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of

Watts *et al.* (U.S. Patent No. 6,559,971) and **Oakeson** *et al.* (U.S. Patent No.

6,618,563).

Regarding **claims 1 and 23**, the Applicant argues that **Sesek** *et al.* (U.S. Patent

No. 7,151,611) does not disclose, teach or suggest using a default media selection

parameter for a print operation, upon receiving a print job from a print client, if a default

media selection override parameter associated with the printer is activated (*see*

Remarks 7/15/2009 [page 14]).

However, Watts does disclose using a default media selection parameter for a

print operation, upon receiving a print job from a print client, if a default media selection

override parameter associated with the printer is activated (*see Fig. 1 wherein preferred*

media size 75 is equivalent to a default media selection override parameter associated

with the printer and see Figs. 2 – 4 and 6 wherein PostScript commands are interpreted

and scale factors are calculated in step 340 and then the image is scaled to fit [default]

preferred media size for printing in step 345).

Therefore, the Applicant's arguments regarding claims 1 and 23 are considered

not persuasive. Please cite rationale of the grounds of rejection below for further

explanation.

3.   Regarding **claims 10 and 27**, the Applicant argues that **Rosekrans *et al.*** (U.S.

Patent No. 5,450,571) does not disclose, teach or suggest, in response to receiving the

print operation from the print client, determining if media selection parameters received

from the print client device indicated in the print operation are operational (*see Remarks*

7/15/2009 [page 15]).

However, Watts does disclose determining if media selection parameters

received from the print client device indicated in the print operation are operational in

response to receiving the print operation from the print client (*see Figs. 1 and 5 wherein*

demonstration page data 60 includes control language 210 that identifies an original

media size/type [e.g. letter, A4, legal, etc.] associated with the stored image 205 and

see Figs. 2 – 4 wherein original media size/type embedded in control section 210 is

compared with [default] preferred media data 75 in order to determine if print operation

is operational).

Therefore, the Applicant's arguments regarding claims 10 and 27 are considered

not persuasive. Please cite rationale of the grounds of rejection below for further

explanation.

4.   Regarding **claims 30 and 41**, the Applicant argues that Rosekrans does not

disclose, teach or suggest a multi-media printer capable of performing print operations

utilizing a plurality of different printing technologies (*see Remarks 7/15/2009 [page 16]*).

        However, Oakeson does disclose a multi-media printer capable of performing

print operations utilizing a plurality of different printing technologies (*see Fig. 1 wherein

printer 100 comprises laser printing assembly 103 and inkjet head assembly 106*).

        Therefore, the Applicant's arguments regarding claims 30 and 41 are considered

not persuasive. Please cite rationale of the grounds of rejection below for further

explanation.

Specification

5.   The amendments to the specification were received on 7/15/2009. These

amendments are acceptable.

Claim Objections

6.   **Claim 1** objected to because of the following informalities: incorrect verb tense.

It is suggested that "a first media selection parameter to be utilize for selecting" is

revised to read "a first media selection parameter to be ~~utilize~~ utilized for selecting."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

8.   ***Claims 36 – 40*** are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

9.   **Claim 36** recites the limitation "the print job media selection parameters" in line

10. There is insufficient antecedent basis for this limitation in the claim. All claims

dependent upon this claim suffer the same deficiency and, therefore, are rejected as

well.

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

11.   ***Claims 1 – 16, 23 – 28 and 30 – 48*** are rejected under 35 U.S.C. 101 because

the claimed invention is directed to ineligible subject matter.

        Regarding **claims 1, 10 and 41**, although the claimed process particularly

transforms a particular article to a different state or thing (e.g. overriding a first media

selection parameter by substituting a second media selection parameter associated with

a default for the printer) wherein the particular articles are the electronic data which

represent actual print media used in a printer, the mere presence of a machine tie or

transformation is not sufficient to pass the test. The particular transformation must meet

two corollaries to pass the test for subject matter eligibility. First, the use of the

particular transformation of the particular article must impose a meaningful limit on the claim's scope rather than a mere field-of-use limitation.

A "field-of-use" limitation does not impose actual boundaries on the scope of the claimed invention. A field-of-use limitation merely indicates that the method is for use in a particular environment, such as "for use with a machine" or "for transforming an article," which would not require that the machine implement the method or that the steps of the method cause the article to transform.

The claimed transformation is merely a field-of-use limitation, which is the configuration of a multi-media printer, yet does not impose any meaningful limit on the claim's scope because the transformation neither requires a machine to implement said process nor that the process positively causes the article to transform. See "Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. §101" Memorandum.

12.   Regarding **claims 23, 27, 30 and 36**, the subject matter of the claim is not directed to one of the four subject matter categories. A claim that covers both statutory and non-statutory embodiments (under the broadest reasonable interpretation of the claim when read in light of the specification and in view of one skilled in the art) embraces subject matter that is not eligible for patent protection and therefore is directed to non-statutory subject matter. Specifically, the claimed "machine-readable storage medium" and "module" can reasonably comprise statutory matter, such as a compact disc, as well as non-statutory matter, such as a carrier wave, and thus, is

rejected as being directed to ineligible subject matter. See "Interim Examination

Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. §101"

Memorandum.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14.   *Claims 1 – 5, 8, 9 and 23 – 26* are rejected under 35 U.S.C. 102(a) and under

35 U.S.C. 102(e) as being anticipated by **Watts *et al.*** (U.S. Patent No. 6,559,971).

Referring to **claim 1**, Watts discloses a method of configuring a multi-media

printer (*see Figs. 1 – 4 wherein printer 10 processes and prints demonstration page

data 60 on variably sized media [Abstract, column 2, line 65 – column 3, line 2 and

column 4, lines 44 – 46]*), comprising:

receiving a print operation from a print client device (*see Fig. 1 wherein an

external device, such as host 37, can send demonstration page data 60 to printer 10 via

I/O port 35 for printing as output page 45 [column 4, lines 9 – 24]*), the print operation

from the print client device comprising a first media selection parameter to be utilize for

selecting a first medium to be used for the print operation (*see Fig. 6 wherein control data 210 of demonstration page data 60 is customized to not specify media size in step 310, which suggests that the original media size stored in control 210 is ignored [column 6, lines 1 – 26 and column 7, lines 15 – 17]*), and

automatically utilizing default media selection parameters for the print operation (*see Figs. 2 – 4 and 6 wherein PostScript commands are interpreted and scale factors are calculated in step 340 and then the image is scaled to fit [default] preferred media size for printing in step 345 [Abstract, column 5, lines 49 – 56 and column 7, lines 46 – 51]*) if a default media selection override parameter associated with the printer is activated (*see Fig. 1 wherein preferred media size 75 is equivalent to a default media selection override parameter associated with the printer [column 3, line 62 – column 4, line 4]*), wherein the default media selection override parameter is programmable (*see Fig. 1 wherein preferred media size 75 is either user-programmable or NVRAM 70 reads the override parameter from ROM 65 upon initialization in step 320 [column 3, line 65 – column 4, line 4 and column 7, lines 27 – 36]*) and is to be utilized for selecting a second medium that is different than the first medium to be used for the print operation (*see Fig. 6 wherein control data 210 of demonstration page data 60 is customized to not specify media size in step 310, which suggests that the original media size stored in control 210 is ignored [column 6, lines 1 – 26 and column 7, lines 15 – 17], and wherein [default] predefined media size 75 is substituted [read into] the demonstration page print job in step 335 [column 7, lines 43 – 46]*).

Referring to **claims 2 – 4**, Watts discloses the method further wherein the

overriding default media selection override parameter is programmable via the print

client device, via an operation panel of the multi-media printer (*see Fig. 1, control panel*

80, host 37 [column 1, lines 24 – 29, column 3, lines 65 – 67 and column 7, lines 31 –

34]) or via a presence of a configuration memory by the multi-media printer (*see Fig. 1,*

NVRAM 70 comprising preferred media size 75).

Referring to **claim 5**, Watts discloses the method further wherein the default

media selection parameters are a single default set of settings applied to all print

operations (*see Fig. 5 wherein a single demonstration page data 60 automatically*

resizes itself to best-fit any given [default] preferred media size 75 associated with

printer 10 [column 2, lines 10 – 13]).

Referring to **claim 8**, Watts discloses the method further wherein the default

media selection parameters include default settings selected based on a size of a

source image as specified in the print operation (*see Figs. 2 – 4 wherein one mode*

does not resize image 110 of media size 105 if the original size of demonstration page

data 60 corresponds with the [default] preferred media size [column 5, lines 8 – 15]

whereas another mode resizes image 110 to one of images 130, 150 to fit respectively

different media sizes 135, 155 if the original size of demonstration page data 60 does

not correspond with the [default] preferred media size [column 5, lines 49 – 56]).

Referring to **claim 9**, Watts discloses the method further wherein the default

media selection parameters are selected based on a modality of the print operation (*see*

Figs. 2 – 4 wherein one mode does not resize image 110 of media size 105 if the

original size of demonstration page data 60 corresponds with the [default] preferred

media size [column 5, lines 8 – 15] whereas another mode resizes image 110 to one of

images 130, 150 to fit respectively different media sizes 135, 155 if the original size of

demonstration page data 60 does not correspond with the [default] preferred media size

[column 5, lines 49 – 56]).

Referring to **claim 10**, Watts discloses a method of configuring a multi-media

printer (*see Figs. 1 – 4 wherein printer 10 processes and prints demonstration page*

data 60 on variably sized media [Abstract, column 2, line 65 – column 3, line 2 and

column 4, lines 44 – 46]), comprising:

receiving a print operation from a print client device (*see Fig. 1 wherein an*

external device, such as host 37 [i.e. print client device], can send demonstration page

data 60 to printer 10 via I/O port 35 for printing as output page 45 [column 4, lines 9 –

24]),

<u>in response to receiving the print operation from the print client device,</u>

determining if media selection parameters <u>received from the print client device,</u>

including media type and media size, indicated in the print operation are operational

(*see Figs. 1 and 5 wherein demonstration page data 60 includes control language 210*

that identifies an original media size/type [e.g. letter, A4, legal, etc.] associated with the

stored image 205 [Abstract, column 2, lines 26 – 31, column 3, lines 37 – 39 and 50 –

56] and see Figs. 2 – 4 wherein original media size/type embedded in control section

210 is compared with [default] preferred media data 75 in order to determine if print

operation is operational [column 4, lines 37 – 46 and column 5, lines 8 – 15]), and

utilizing a default media selection parameter of potential media selection

parameters for the print operation (*see Figs. 2 – 4 and 6 wherein PostScript commands*

are interpreted and scale factors are calculated in step 340 and then the image is

scaled to fit [operational] preferred media size for printing in step 345 [Abstract, column

5, lines 49 – 56 and column 7, lines 46 – 51]) if one of the media selection parameters is

not operational (*see Figs. 2 – 4 wherein one mode [e.g. operational mode] does not*

resize image 110 of media size 105 if the original size of demonstration page data 60

corresponds with the default preferred media size [column 5, lines 8 – 15] whereas

another mode [e.g. non-operational mode] resizes image 110 to one of images 130, 150

to fit respectively different media sizes 135, 155 if the original size of demonstration

page data 60 does not correspond with the [default] preferred media size [column 5,

lines 49 – 56]), wherein the default media selection parameter is programmable (*see*

Fig. 1 wherein preferred media size 75 is either user-programmable or NVRAM 70

reads the override parameter from ROM 65 upon initialization in step 320 [column 3,

line 65 – column 4, line 4 and column 7, lines 27 – 36]).

Referring to **claim 11**, Watts discloses the method further including combining an

operational media selection parameter with the default media selection parameter and

determining if the combining of the operational media selection parameter with the

default media selection parameter is supported (*see Figs. 1 and 5 wherein*

demonstration page data 60 includes control language 210 that identifies an original

media size/type [e.g. letter, A4, legal, etc.] associated with the stored image 205

[Abstract, column 2, lines 26 – 31, column 3, lines 37 – 39 and 50 – 56] and see Figs. 2

– 4 wherein original media size/type embedded in control section 210 is compared with

[default] preferred media data 75 in order to determine if print operation is operational

[column 4, lines 37 – 46 and column 5, lines 8 – 15]).

Referring to **claim 12**, Watts discloses the method further wherein the potential

default media selection parameters are a single default set of settings applied to all print

operations (*see Fig. 5 wherein a single demonstration page data 60 automatically*

resizes itself to best-fit any given [default] preferred media size 75 associated with

printer 10 [column 2, lines 10 – 13]).

Referring to **claim 15**, Watts discloses the method further wherein the potential

default media selection parameters include default settings selected based on a size of

a source image as specified in the print operation (*see Figs. 2 – 4 wherein one mode*

does not resize image 110 of media size 105 if the original size of demonstration page

data 60 corresponds with the [default] preferred media size [column 5, lines 8 – 15]

whereas another mode resizes image 110 to one of images 130, 150 to fit respectively

different media sizes 135, 155 if the original size of demonstration page data 60 does

not correspond with the [default] preferred media size [column 5, lines 49 – 56]).

Referring to **claim 16**, Watts discloses the method further wherein the potential

default media selection parameters are selected based on a modality of the print

operation (*see Figs. 2 – 4 wherein one mode does not resize image 110 of media size*

105 if the original size of demonstration page data 60 corresponds with the [default]

preferred media size [column 5, lines 8 – 15] whereas another mode resizes image 110

to one of images 130, 150 to fit respectively different media sizes 135, 155 if the original

size of demonstration page data 60 does not correspond with the [default] preferred

media size [column 5, lines 49 – 56]).

Referring to **claims 23 – 28**, the rationale provided above in rejections of claims

1 – 4, 10 and 11, respectively, are incorporated herein. The methods of claims 1 – 4,

10 and 11 are stored as programs of instructions of claims 23 – 28, respectively, within

memory and executed by one or more processors (*see Fig. 1, microprocessor 15, ROM*

65, RAM 40, NVRAM 70 [column 3, lines 2 – 4 and column 3, line 16 – column 4, line

4]).

Claim Rejections - 35 USC § 103

15.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

16.   ***Claims 6, 7, 13 and 14*** are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Watts** *et al.* (U.S. Patent No. 6,559,971) in view of **Simpson** *et al.*

(U.S. Pre-Grant Publication No. 2003/0011801).

Referring to **claims 6 and 13**, Watts discloses the method as discussed above in

the rejections of claims 1 and 10 but does not explicitly disclose the method further

wherein the default media selection parameters include a set of grayscale default

settings and a set of color default settings.

Simpson discloses the method wherein the default media selection parameters

(*see Fig. 3 wherein print option selector 248 is comprised within printer 224 and begins*

with a default set of print options for a print request and then overrides individual

settings in the default set based upon history 252 and rules 250 [paragraphs 0041, 0042

and 0045 – 0047] and see paragraph 0021 wherein each print option [e.g. a particular

print media source from a loaded input tray, which is analogous to a media selection]

used to configure a printer affects how the printer will print documents it receives)

include a set of grayscale default settings and a set of color default settings (*paragraph*

0043 wherein monochrome is analogous to a grayscale setting).

Watts and Simpson are combinable because they are from the same field of

endeavor, being print option configuration of a printer based upon specific, user-defined

print job requirements. At the time of the invention, it would have been obvious to one

of ordinary skill in the art to include allowing certain default parameters to be overridden.

The suggestion/motivation for doing so would have been to improve the user's ability to

configure printers in a user-friendly manner such that one or more print options to be

used in a print request are automatically selected based at least in part on one or more

characteristics of the print request, as suggested by Simpson (*paragraphs 0004, 0007,*

0021 and 0060).

Referring to **claims 7 and 14**, Watts discloses the method as discussed above in

the rejections of claims 1 and 10 but does not explicitly disclose the method further

wherein the default media selection parameters include default settings based on a

number of images printed on a single sheet as specified in the print operation.

Simpson discloses the method wherein the default media selection parameters

(*see Fig. 3 wherein print option selector 248 is comprised within printer 224 and begins*

with a default set of print options for a print request and then overrides individual

settings in the default set based upon history 252 and rules 250 [paragraphs 0041, 0042

and 0045 – 0047] and see paragraph 0021 wherein each print option [e.g. a particular

print media source from a loaded input tray, which is analogous to a media selection]

used to configure a printer affects how the printer will print documents it receives)

include default settings based on a number of images printed on a single sheet as

specified in the print operation (*see Fig. 3 wherein, for example, selector 248 changes*

the copy count to 2 whenever the document name ends with "JPG and the length set is

one page because at least 50% of the time, according to the user print history 252, the

user requests two copies of a document one page in length and ending in "JPG"

[paragraph 0047]).

Watts and Simpson are combinable because they are from the same field of

endeavor, being print option configuration of a printer based upon specific, user-defined

print job requirements. At the time of the invention, it would have been obvious to one

of ordinary skill in the art to include allowing certain default parameters to be overridden.

The suggestion/motivation for doing so would have been to improve the user's ability to

configure printers in a user-friendly manner such that one or more print options to be

used in a print request are automatically selected based at least in part on one or more

characteristics of the print request, as suggested by Simpson (*paragraphs 0004, 0007,*

0021 and 0060).

17.   ***Claims 30 and 32 – 35*** are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Rosekrans** *et al.* (U.S. Patent No. 5,450,571) in view of **Oakeson** *et*

al. (U.S. Patent No. 6,618,563).

Referring to **claim 30**, Rosekrans discloses a multi-media printer, comprising:

a decoding module (*see Figs. 1, 2 and 6, server 25*) to receive print job

parameters and print job data for a print job (*see Fig. 2 wherein each print job consists*

of the print job, referred to as electronic document 45, and a job ticket 35 which contains

programming parameters for the job entered via user interface 16 [column 3, lines 15 –

25 and 29 – 37]), to decode the print job parameters and the print job data to create

decoded print job parameters including decoded print job media selection parameters

(*see Figs. 1, 2, 5 and 6 wherein user interface 16 provides user with a large selection of*

print stock size, type and color [i.e. print media selections] [column 4, lines 44 – 52]) and

decoded print job data, and to output the decoded print job parameters including the

decoded print job media selection parameters and the decoded print job data (*see Figs.*

1, 2 and 6 wherein a processor in server 25 processes the electronic documents 45 for

printing, or outputting, by the selected printer [column 2, lines 63 – 68 and column 4,

lines 20 – 37]),

a configuration memory to store default configuration parameters (*see Figs. 6 – 8*

wherein printer UI mask 55 stores print default selections based upon printer

configuration file 52 and family mask 50 [column 5, lines 30 – 40 and column 6, lines 25

– 30]), and

a parameter determination module to receive the decoded print job parameters

including the decoded print job media selection parameters and the decoded print job

data (*see Figs. 6 and 8 wherein substitution process 62 receives user-selected print*

parameters from job ticket 35-2 [column 5, lines 61 – 66, column 6, lines 1 – 4 and 9 –

30]), to receive the default configuration parameters including default media selection

parameters from the configuration memory (*column 6, lines 28 – 30*), and to determine

final print job media selection parameters for the print job utilizing the decoded print job

media selection parameters and the default media selection parameters (*see Figs. 6 – 8*

wherein substitution process 62 determines final operational printing options available

by substituting user-selected print settings with acceptable default print settings for that

particular printer 12 [column 2, lines 57 – 62, column 6, lines 9 – 30 and 52 – 62]),

wherein the default media selection parameters stored by the configuration

memory comprise parameters for identifying a default media to be used for performing a

print operation (*see Figs. 6 – 8 wherein printer UI mask 55 is substituted to provide a*

different selection [e.g. default selection] whenever the provided selection of job ticket

35-2 is impermissible [column 6, lines 17 – 30 and 53 – 62]) but does not explicitly

disclose the printer further performing a print operation with each of a plurality of

different printing technologies.

Oakeson discloses the printer performing a print operation with each of a plurality

of different printing technologies (*see Fig. 1 wherein printer 100 comprises laser printing*

assembly 103 and inkjet head assembly 106 [Abstract, column 1, lines 37 – 48 and

column 2, liens 61 – 63]).

Rosekrans and Oakeson are combinable because they are from the same field of

endeavor, being printing on various print media. At the time of the invention, it would

have been obvious to one of ordinary skill in the art to include printing with at least two

different printing technologies. The suggestion/motivation for doing so would have been

to optimize printing on various print media, as suggested by Oakeson (*column 1, lines*

20 – 33 and column 2, lines 1 – 12).

Furthermore, one of ordinary skill in the art would have recognized that applying

the Oakeson's known technique of attaching an inkjet head assembly to the printer

structure would have yielded predictable results and resulted in an improved system

wherein Rosekrans teaches that printers may comprise laser printers and ink jet

printers. See MPEP 2143 D and G.

Referring to **claim 32**, Rosekrans discloses the apparatus further wherein the

parameter determination module identifies that the decoded print job media selection

parameters are not operational to establish media selection parameters (*column 6, lines*

52 – 62) and the default media selection parameters are selected as the final media

selection parameters for the print job (*column 6, lines 9 – 30*).

Referring to **claims 33 and 34**, Rosekrans discloses the apparatus further

wherein the parameter determination module identifies that the decoded print job media

selection parameters are partially operational (*see Fig. 8 wherein substitution process*

62 identifies both user-selected print media size and type in job ticket 35-2), utilizes the

default configuration media selection parameters to supplement the decoded print job

media selection parameters to create the final media selection parameters (*see Fig. 8*

wherein substitution process 62 determines final operational print options available by

supplementing the combination of print settings, either the user-selected print media

size and/or print media type, with acceptable default print settings for that particular

printer 12 [column 2, lines 57 – 62 and column 6, lines 9 – 30]), verifies that a

combination of the default configuration media selection parameters and the decoded

print job media selection parameters are operational (*see Fig. 7, validation 64 [column*

6, lines 42 – 52]), and if the combination of the default configuration media selection

parameters and the decoded print job media selection parameters are not operational

(*column 6, lines 52 – 62*), utilizes the default configuration media selection parameters

as the final media selection parameters (*column 6, lines 9 – 30*).

Referring to **claim 35**, Rosekrans and Oakeson disclose the apparatus as

discussed above in the rejection of claim 30 but does not explicitly disclose the

apparatus further wherein the configuration memory is a non-volatile memory.

However, the Examiner takes Official Notice that memory which is non-volatile is

well known in the art.

It would have been obvious at the time the invention was made to one of ordinary

skill in the art to ensure the default print configurations will still ready and available upon

booting the system since the Examiner takes Official Notice that loading default system

configuration settings from a non-volatile memory is well known in the art.

18.   *Claim 31* is rejected under 35 U.S.C. 103(a) as being unpatentable over

Rosekrans *et al.* (U.S. Patent No. 5,450,571) in view of **Oakeson** *et al.* (U.S. Patent

No. 6,618,563) and further in view of **Sesek** (U.S. Patent No. 7,151,611).

Referring to **claim 31**, Rosekrans and Oakeson disclose the apparatus as

discussed above in the rejection of claim 30 but does not explicitly disclose the

apparatus further wherein an always use default setting is established and the

parameter determination module selects the default media selection parameters as the

final media selection parameters.

Sesek discloses the apparatus wherein an always use default setting is

established and the parameter determination module selects the default media selection

parameters as the final media selection parameters (*see Fig. 3 wherein the "always*

use" default option when either the user chooses not to activate the Printer Options

Retention Enable button 86 and always print using default values in steps 90 – 91

[column 2, lines 51 – 57, column 4, lines 11 – 15 and 34 – 36] or when the retention

time period has expired and printer properties revert to always use their default values

indefinitely hereinafter in steps 92, 98 – 99 [column 1, lines 7 – 11, column 2, lines 54 –

57, column 4, lines 7 – 11 and 45 – 48]).

Rosekrans and Sesek are combinable because they are from the same field of

endeavor, being print option configuration of a printer that facilitates the determination of

proper print modes. At the time of the invention, it would have been obvious to one of

ordinary skill in the art to include allowing the user to toggle between always using

default print settings or when to override those default values. The

suggestion/motivation for doing so would have been to conveniently give the user

discretion over when to always use conventional default settings and when to revert to

those same conventional default settings after a temporary time period always

hereinafter, as suggested by Sesek (*column 1, lines 7 – 11, column 2, lines 30 – 44, 51*

– 57 and column 4, line 66 – column 5, line 3).

19.   ***Claims 36 and 38 – 40*** are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Rosekrans** *et al.* (U.S. Patent No. 5,450,571) in view of **Ozaki** (U.S.

Patent No. 6,912,061) and further in view of **Oakeson** *et al.* (U.S. Patent No.

6,618,563).

Referring to **claim 36**, Rosekrans discloses a system, comprising:

a plurality of computing devices (*see Fig. 1, clients 15-1 – 15-N [column 3, lines*

11 – 37]) to transmit print jobs including print job parameters and print job data (*see Fig.*

2 wherein each print job consists of the print job, referred to as electronic document 45,

and a job ticket 35 which contains programming parameters for the job entered via user

interface 16 [column 3, lines 15 – 25 and 29 – 37]),

a printer (*see Fig. 1, printers 12-1 – 12-N*) to receive the print jobs from the

plurality of computing devices and to create an image from the print job data according

to the print job parameters (*column 2, line 65 – column 3, line 10*),

a decoding module (*see Figs. 1, 2 and 6, server 25*) to receive print job

parameters and print job data for a print job (*see Fig. 2 wherein each print job consists*

of the print job, referred to as electronic document 45, and a job ticket 35 which contains

programming parameters for the job entered via user interface 16 [column 3, lines 15 –

25 and 29 – 37]), to decode the print job parameters and the print job data to create

decoded print job parameters including decoded print job media selection parameters

(*see Figs. 1, 2, 5 and 6 wherein user interface 16 provides user with a large selection of*

print stock size, type and color [i.e. print media selections] [column 4, lines 44 – 52]) and

decoded print job data, and to output the decoded print job parameters including the

decoded print job media selection parameters and the decoded print job data (*see Figs.*

1, 2 and 6 wherein a processor in server 25 processes the electronic documents 45 for

printing, or outputting, by the selected printer [column 2, lines 63 – 68 and column 4,

lines 20 – 37]),

a configuration memory to store default configuration parameters (*see Figs. 6 – 8*

wherein printer UI mask 55 stores print default selections based upon printer

configuration file 52 and family mask 50 [column 5, lines 30 – 40 and column 6, lines 25

– 30]), and

a parameter determination module to receive the decoded print job parameters

including the decoded print job media selection parameters and the decoded print job

data (*see Figs. 6 and 8 wherein substitution process 62 receives user-selected print*

parameters from job ticket 35-2 [column 5, lines 61 – 66, column 6, lines 1 – 4 and 9 –

30]), to receive the default configuration parameters including default media selection

parameters from the configuration memory (*column 6, lines 28 – 30*), and to determine

final print job media selection parameters for the print job utilizing the decoded print job

media selection parameters and the default media selection parameters (*see Figs. 6 – 8*

wherein substitution process 62 determines final operational printing options available by substituting user-selected print settings with acceptable default print settings for that particular printer 12 [column 2, lines 57 – 62, column 6, lines 9 – 30 and 52 – 62]) but does not explicitly disclose a multi-media printer that utilizes at least two printing technologies included within a medical imaging system, comprising a plurality of computing devices to transmit print jobs including print job parameters and print job data, a plurality of medical imaging devices to transmit print jobs including print job parameters and print job data, and a multi-media printer to receive the print jobs from either the plurality of computing devices or the plurality of medical imaging devices and to create an image from the print job data according to the print job parameters.

Ozaki discloses the multi-media printer (*see Fig. 1, printers 201, 202 [column 5, line 61 – column 6, line 15]*) included within a medical imaging system (*see Fig. 1, network system 100 [Abstract and column 5, lines 27– 42]*), wherein the system comprising:

a plurality of computing devices (*see Fig. 1, workstations 10A, 10B*) to transmit print jobs including print job parameters and print job data (*column 6, lines 41 – 50 wherein it is well-known in the art that workstations 10A, 10B submit print jobs via a network [e.g. LAN, WAN] to printers 201, 202*),

a plurality of medical imaging devices (*see Fig. 1, medical modalities 50A – 50F*) to transmit print jobs including print job parameters and print job data (*column 5, lines 49 – 54*), and

the multi-media printer to receive the print jobs from either the plurality of computing devices or the plurality of medical imaging devices and to create an image from the print job data according to the print job parameters (*column 5, line 61 – column 6, line 40*) but does not explicitly disclose the multi-media printer <u>that utilizes at least two printing technologies.</u>

Oakeson discloses the multi-media printer <u>that utilizes at least two printing technologies</u> (*see Fig. 1 wherein printer 100 comprises laser printing assembly 103 and inkjet head assembly 106 [Abstract, column 1, lines 37 – 48 and column 2, liens 61 – 63]*).

Rosekrans and Ozaki are combinable because they are from the same field of endeavor, being networked printing systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to connect several different medical imaging devices to a multi-media printer. The suggestion/motivation for doing so would have been to print acquired images from medical imaging devices at various sizes, as suggested by Ozaki (*column 1, lines 17 – 25 and column 6, lines 1 – 15*).

Rosekrans and Oakeson are combinable because they are from the same field of endeavor, being printing on various print media. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include printing with at least two different printing technologies. The suggestion/motivation for doing so would have been to optimize printing on various print media, as suggested by Oakeson (*column 1, lines 20 – 33 and column 2, lines 1 – 12*).

Furthermore, one of ordinary skill in the art would have recognized that applying

the Oakeson's known technique of attaching an inkjet head assembly to the printer

structure would have yielded predictable results and resulted in an improved system

wherein Rosekrans teaches that printers may comprise laser printers and ink jet

printers. See MPEP 2143 D and G.

Referring to **claims 38 and 39**, the rationale provided above in the rejections of

claims 32 and 33, respectively, are incorporated herein. In addition, the apparatus of

claims 32 and 33 include the limitations and elements of the system of claims 38 and

39, respectively.

Referring to **claim 40**, Rosekrans, Ozaki and Oakeson disclose the system as

discussed above in the rejection of claim 36 but does not explicitly disclose the

apparatus further wherein the configuration memory is a non-volatile memory.

However, the Examiner takes Official Notice that memory which is non-volatile is

well known in the art.

It would have been obvious at the time the invention was made to one of ordinary

skill in the art to ensure the default print configurations will still ready and available upon

booting the system since the Examiner takes Official Notice that loading default system

configuration settings from a non-volatile memory is well known in the art.

20.   *Claim 37* is rejected under 35 U.S.C. 103(a) as being unpatentable over

Rosekrans *et al.* (U.S. Patent No. 5,450,571) in view of **Ozaki** (U.S. Patent No.

6,912,061) in view of **Oakeson et al.** (U.S. Patent No. 6,618,563) and further in view of

Sesek (U.S. Patent No. 7,151,611).

Referring to **claim 37**, Rosekrans, Ozaki and Oakeson disclose the apparatus as

discussed above in the rejection of claim 36 but does not explicitly disclose the

apparatus further wherein an always use default setting is established and the

parameter determination module selects the default media selection parameters as the

final media selection parameters.

Sesek discloses the apparatus wherein an always use default setting is

established and the parameter determination module selects the default media selection

parameters as the final media selection parameters and the default media selection

parameters are utilized to produce the image along with the decoded print data (*see*

Fig. 3 wherein the "always use" default option when either the user chooses not to

activate the Printer Options Retention Enable button 86 and always print using default

values in steps 90 – 91 [column 2, lines 51 – 57, column 4, lines 11 – 15 and 34 – 36] or

when the retention time period has expired and printer properties revert to always use

their default values indefinitely hereinafter in steps 92, 98 – 99 [column 1, lines 7 – 11,

column 2, lines 54 – 57, column 4, lines 7 – 11 and 45 – 48]).

Rosekrans and Sesek are combinable because they are from the same field of

endeavor, being print option configuration of a printer that facilitates the determination of

proper print modes. At the time of the invention, it would have been obvious to one of

ordinary skill in the art to include allowing the user to toggle between always using

default print settings or when to override those default values. The

suggestion/motivation for doing so would have been to conveniently give the user

discretion over when to always use conventional default settings and when to revert to

those same conventional default settings after a temporary time period always

hereinafter, as suggested by Sesek (*column 1, lines 7 – 11, column 2, lines 30 – 44, 51*

– 57 and column 4, line 66 – column 5, line 3).

21.   ***Claims 41 – 45 and 48*** are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Watts *et al.*** (U.S. Patent No. 6,559,971) in view of **Oakeson *et al.***

(U.S. Patent No. 6,618,563).

Referring to **claim 41**, Watts discloses the method of configuring a multi-media

printer as discussed above in the rejection of claim 1 but does not explicitly disclose the

method further wherein the multi-media printer utilizes two printing technologies.

Oakeson discloses the method further wherein the multi-media printer utilizes

two printing technologies (*see Fig. 1 wherein printer 100 comprises laser printing*

assembly 103 and inkjet head assembly 106 [Abstract, column 1, lines 37 – 48 and

column 2, liens 61 – 63]).

Watts and Oakeson are combinable because they are from the same field of

endeavor, being printing on various print media. At the time of the invention, it would

have been obvious to one of ordinary skill in the art to include printing with at least two

different printing technologies. The suggestion/motivation for doing so would have been

to optimize printing on various print media, as suggested by Oakeson (*column 1, lines*

20 – 33 and column 2, lines 1 – 12).

Furthermore, one of ordinary skill in the art would have recognized that applying

the Oakeson's known technique of attaching an inkjet head assembly to the printer

structure would have yielded predictable results and resulted in an improved system

wherein Watts teaches that printers may comprise laser printers as well as ink jet

printers. See MPEP 2143 D and G.

Referring to **claims 42 – 45 and 48**, the rationale provided above in the

rejections of claims 2 – 5 and 8, respectively, are incorporated herein. In addition, the

methods of claims 2 – 5 and 8 include the elements and limitations of the methods of

claims 42 – 45 and 48, respectively.

22.   ***Claims 46 and 47*** are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Watts *et al.*** (U.S. Patent No. 6,559,971) in view of **Oakeson *et al.*** (U.S. Patent

No. 6,618,563) and further in view of **Simpson *et al.*** (U.S. Pre-Grant Publication No.

2003/0011801).

Referring to **claim 46**, Watts and Oakeson disclose the method as discussed

above in the rejection of claim 41 but does not explicitly disclose the method further

wherein the default media selection parameters include a set of grayscale default

settings and a set of color default settings.

Simpson discloses the method wherein the default media selection parameters

(*see Fig. 3 wherein print option selector 248 is comprised within printer 224 and begins*

with a default set of print options for a print request and then overrides individual

settings in the default set based upon history 252 and rules 250 [paragraphs 0041, 0042

and 0045 – 0047] and see paragraph 0021 wherein each print option [e.g. a particular

print media source from a loaded input tray, which is analogous to a media selection]

used to configure a printer affects how the printer will print documents it receives)

include a set of grayscale default settings and a set of color default settings (*paragraph*

0043 wherein monochrome is analogous to a grayscale setting).

Watts and Simpson are combinable because they are from the same field of

endeavor, being print option configuration of a printer based upon specific, user-defined

print job requirements. At the time of the invention, it would have been obvious to one

of ordinary skill in the art to include allowing certain default parameters to be overridden.

The suggestion/motivation for doing so would have been to improve the user's ability to

configure printers in a user-friendly manner such that one or more print options to be

used in a print request are automatically selected based at least in part on one or more

characteristics of the print request, as suggested by Simpson (*paragraphs 0004, 0007,*

0021 and 0060).

Referring to **claim 47**, Watts and Oakeson disclose the method as discussed

above in the rejections of claim 41 but does not explicitly disclose the method further

wherein the default media selection parameters include default settings based on a

number of images printed on a single sheet as specified in the print operation.

Simpson discloses the method wherein the default media selection parameters

(*see Fig. 3 wherein print option selector 248 is comprised within printer 224 and begins*

with a default set of print options for a print request and then overrides individual

settings in the default set based upon history 252 and rules 250 [paragraphs 0041, 0042

and 0045 – 0047] and see paragraph 0021 wherein each print option [e.g. a particular

print media source from a loaded input tray, which is analogous to a media selection]

used to configure a printer affects how the printer will print documents it receives)

include default settings based on a number of images printed on a single sheet as

specified in the print operation (*see Fig. 3 wherein, for example, selector 248 changes*

the copy count to 2 whenever the document name ends with "JPG and the length set is

one page because at least 50% of the time, according to the user print history 252, the

user requests two copies of a document one page in length and ending in "JPG"

[paragraph 0047]).

Watts and Simpson are combinable because they are from the same field of

endeavor, being print option configuration of a printer based upon specific, user-defined

print job requirements. At the time of the invention, it would have been obvious to one

of ordinary skill in the art to include allowing certain default parameters to be overridden.

The suggestion/motivation for doing so would have been to improve the user's ability to

configure printers in a user-friendly manner such that one or more print options to be

used in a print request are automatically selected based at least in part on one or more

characteristics of the print request, as suggested by Simpson (*paragraphs 0004, 0007,*

0021 and 0060).

Allowable Subject Matter

23.   The indicated allowability of **claims 41 – 48** is withdrawn in view of the newly

discovered reference to **Oakeson** *et al.* (U.S. Patent No. 6,618,563). Rejections based

on the newly cited reference(s) are cited above.

Conclusion

24.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Wu (U.S. Patent No. 7,133,152) discloses a post RIP paper conversion which

converts an image to the available paper size being used by the image forming

apparatus (*see Abstract and Fig. 1*).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Myles D. Robinson whose telephone number is

(571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Myles D. Robinson/
Examiner, Art Unit 2625
11/24/09

/Twyler L. Haskins/
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